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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,296	12/04/2003	Emmanuel Van Heygen	R0136.70014US01	7110

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EXAMINER

SMITH, KIMBERLY S

ART UNIT	PAPER NUMBER
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3644

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/728,296

Applicant(s)

HEYGEN, EMMANUEL VAN

Examiner

Kimberly S Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-16 and 18-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-16 and 18-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Arguments***

1. Applicant's arguments with respect to claims 6-16 have been considered but are moot in view of the new ground(s) of rejection.

***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: new Figure 5A includes reference number "66". Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 10 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to how the passage is defined in part by the first surface area of the first body when the independent claim states the passage extends from the cavity to the surface area of the body *at a location separate* from the portion of the cavity extending to the first surface area?

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 6, 7, 10-12, 15, 18-21, 24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith, US Patent 4,928,631.

Smith discloses a first body having a cavity (i.e. the interior of the bird house), a passage (27), a substantially planar transparent closure (16) distinct from the first body (as it is made of transparent material, it is therefore considered distinct as the body is made from an opaque material) and a second body (11) having a surface complimentary to the first surface for preventing viewing of the cavity.

Regarding claims 7 and 24, Smith discloses the two bodies when oriented with complimentary faces opposite one another form a visually unitary structure (reference Figure 2).

Regarding claims 11, 12 and 26, Smith discloses the complimentary surfaces are planar surfaces of substantially the same size and shape.

Regarding claim 18, Smith discloses at least one ledge in the cavity that forms a tunneling system (i.e. the ladder disclosed in Figures 4 and 7 is considered a ledge, defined as a narrow flat surface or shelf, under which forms a tunnel for the animal).

Regarding claim 19, Smith discloses the transparent closure is positioned adjacent to the complementary surfaces of the first and second bodies.

Regarding claims 20 and 21, reference discussion of claim 6 above. It is noted that a birdhouse is a shape found in nature, as it is notoriously well known that birdhouses are designed for placement in nature. Further, the Smith reference is constructed of lumber that is also a natural product and therefore of a shape found in nature.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 8, 13 and 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, US Patent 4,928,631 in view of Toda (JP 11217161).

Smith discloses the invention substantially as claimed with the exception of using a peg to hold the bodies in registration instead of magnetic members. Toda teaches within the analogous art of peep windows the use of a magnet (5) for holding a shutter in registration with a

window for discrete viewing through the window. It would have been obvious for one having ordinary skill in the art to use the magnetic members taught by Toda with the device of Smith in order to provide discrete viewing through the transparent closure as magnetic closure would lessen the jostling motion when opening and closing the second body thereby creating a more natural habitat for the animal inside.

Regarding claim 13, Toda teaches the magnetic member lies substantially in the surfaces of the body (reference Figures B)

9. Claims 9, 14, 16, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, US Patent 4,928,631.

Smith discloses the invention substantially as claimed. However, Smith does not disclose the bodies creating the image of at least one rock or a single rock. It would have been an obvious matter of design choice to create a housing giving the appearance of at least one rock, a mound of earth or tree stump configuration since the applicant has not disclosed that the appearance of a rock, mound of earth or tree stump configuration solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any appearance. It is noted that the Applicant states at page 1, line 16-17 that the structure is preferably in the shape of an object that appears in nature. Prehart (Des. 368,989) and Daggett (Des. 89,631) are cited to show common design choices in animal habitats which appear in nature.

Regarding claim 16, reference discussion above of claim 11.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lewis, US Patent 3,269,578.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly S Smith whose telephone number is 703-308-8515. The examiner can normally be reached on Monday thru Friday 10:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 703-305-7421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

kss

A handwritten signature in black ink, appearing to read "Teri P. Luu", with a long horizontal flourish extending to the right.

**TERI P. LUU**  
**SUPERVISORY PRIMARY EXAMINER**